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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,594	09/26/2000	Prasad Rajee	004426.P001	5001

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Blakley Sokoloff Taylor & Zafman LLP  
12400 Wilshire Boulevard Seventh Floor  
Los Angeles, CA 90025

EXAMINER
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BASEHOAR, ADAM L

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/669,594	<b>Applicant(s)</b> RAJE, PRASAD	
	<b>Examiner</b> ADAM L. BASEHOAR	<b>Art Unit</b> 2178	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 126-129, 131-140 and 142-154 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 126-129, 131-140 and 142-154 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 2178

### **DETAILED ACTION**

1. This action is responsive to communications: The RCE filed 08/11/08.
2. Claims 130 and 141 have been cancelled as necessitated by Amendment.
3. All previous rejections the claims have been withdrawn as necessitated by Amendment.
4. Claims 126-129, 131-140, and 142-154 are pending. Claims 126, 132, 137, 143 are independent claims.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 126-127, 129, 131-134, 136-138, 140, 142-146, and 148-154 are rejected under 35 U.S.C. 103(a) as being unpatentable over OmniForm User's Manual (hereinafter OmniForm), Caere Corporation, released March 22, 1999 (as evidenced by cited PR NewsWire article), pages 1-108, 173-199, in view of Larson (US-6,088,700 07/11/00).

**In regard to independent claim 126**, OmniForm teaches a form design application for designing, and editing an electronic form (OmniForm pages 25-43). OmniForm teaches opening a form, as well as e-mailing an electronic form using Outlook (OmniForm page 39-43). Since OmniForm can reopen any form in OmniForm format (see OmniForm page 15), Omniform can also receive an already created electronic form via email (typically including input fields). It is noted that an Omniform form is written in a form authoring language. (compare with "*A method*

Art Unit: 2178

*comprising: receiving, through a network, a form authored using a form authoring language, the form containing one or more input fields;”).*

OmniForm teaches opening a form for redesigning, etc. (OmniForm page 15). In doing so, OmniForm reads and analyzes the underlying constructs of said form (which typically includes parsing the code) so as to create and/or re-create active input fields (compare with “*parsing the received form to identify the input fields contained in the received form;*”).

OmniForm teaches a graphical user interface dependent upon (associated with) the form’s input fields (OmniForm at least page 32), as well as the capability of opening a form file (e.g. a specific form submission) emailed from another user (a third party). OmniForm further teaches allowing identification of actions to be associated with the identified input fields upon submission of instance of a form by a third party and automatically generating a program code to carry out the actions associated with the identified input fields, wherein no modifications to the input fields of the form are made by the generation of the program code (Page 73: “set validation options”; Pages 76-77: “set validation options for fill text objects”: i.e. OmniForm teaches wherein via a graphical user interface a form creator/editor can assign validation actions to specific input form fields, whereupon the validation actions are assigned, program code for carrying out said validation is generated/applied to said fields with further use of the forms via third parties requiring said validation actions to be taken on the data input into said input fields via said third parties).

OmniForm generally teaches the creation of forms for eventual third party interaction/submission (Page 15: “Work on a Form’s Design” & “Create a New, Blank Form”; Page 77: e.g. “Allow user to override validation...force the user to enter data in the selected

Art Unit: 2178

field...override the warning”), receiving data from a third party (Page 77: “user enter data in the selected field”), and executing program code on said data in view of said input fields (Page 77: “display a prompt in fill view if the user enters incorrect information in the field”). OmniForm does not specifically teach receiving a specific submission/instance of a data filled in form from a third party and carry out the actions associated with the identified input fields. Larsen et al teach receiving a specific submission of a data filled in form from a third party and carry out the actions associated with the identified input fields (column 2, lines 23-38: “the fully completed forms are then transmitted to the parties requesting the information”; column 3, lines 1-12: “tool validates that all required information has been entered and that the fields that require specific format are correct” & 20-67; column 4, lines 1-50). It would have been obvious to one of ordinary skill in the art at the time of the invention for the OmniForm to have received a specific form submission with filled in form data and validated/processed it as shown in Larsen, because Larsen taught that automatic processing third party form submissions provided a convenient method for filling out and processing forms by eliminating incomplete and incorrect information associated with filling out forms (column 2, lines 5-10 & 63-67: “convenient method....eliminate incomplete and incorrect information”).

**In regard to dependent claim 127**, OmniForm teaches conversion of a form to HTML (OmniForm page 46-47).

**In regard to dependent claim 129**, OmniForm teaches generating program code to create active input fields with associated actions (see OmniForm Chapter 4, page 55).

**In regard to dependent claim 131**, OmniForm teaches validation options for automatically validating input (OmniForm pages 76-77). If input does not validate, the user is notified accordingly.

**In regard to independent claim 132**, claim 132 reflects the system comprising computer readable instructions used for implementing the methods as claimed in claim 126, and is rejected along the same rationale.

**In regard to dependent claim 133**, OmniForm teaches a computer, typically incorporating a processor(s) (OmniForm page 8).

**In regard to dependent claims 134, 136**, claims 134, 136 reflect the system comprising computer readable instructions used for implementing the methods as claimed in claims 127, 131 respectively, and are rejected along the same rationale.

**In regard to claims 137-138, 140, and 142**, claims 137-138, 140 and 142 reflect the computer program product comprising computer readable instructions used for implementing the methods as claimed in claims 126-127, 129-131 respectively, and are rejected along the same rationale.

Art Unit: 2178

**In regard to independent claim 143**, claim 143 incorporates substantially similar subject matter as claimed in claim 126, and in further view of the following, is rejected along the same rationale.

**In regard to dependent claim 144**, OmniForm teaches validation options for automatically validating input (OmniForm pages 76-77). If input does not validate, the user is notified accordingly.

**In regard to dependent claim 145**, OmniForm teaches generating necessary quantities of associations as per input fields (OmniForm at least page 32: e.g. Order Form).

**In regard to dependent claim 146**, OmniForm teaches licensing (OmniForms page 48).

**In regard to dependent claims 148-149**, OmniForm teaches e-mailing a form, and using a routing slip (OmniForm page 40-43).

**In regard to dependent claims 150-151**, OmniForm teaches generating program code to create active input fields with associated actions (see OmniForm Chapter 4, page 55). OmniForm teaches receiving a form in a design phase, including both the form and data (OmniForm page 41).

Art Unit: 2178

**In regard to dependent claims 152-154**, OmniForm teaches management of database records (including data) in a database (typically comprising inclusion of records in various rows of a table (see OmniForm Chapter 7, page 173-199).

7. Claims 128, 135, 139 are rejected under 35 U.S.C. 103(a) as being unpatentable over OmniForm, in view of Larson (US-6,088,700 07/11/00), in further view of PR NewsWire article (hereinafter PR NewsWire), March 22, 1999, ProQuest Direct, pages 1-5.

**In regard to dependent claim 128, 135, 139**, OmniForm does not specifically teach utilizing CGI. However, PR NewsWire teaches instructions for integrating CGI into forms (PR NewsWire page 4 item b). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply PR NewsWire to OmniForm, providing OmniForm the benefit of adding CGI scripting for collecting form data

8. Claims 147 is rejected under 35 U.S.C. 103(a) as being unpatentable over OmniForm, view of Larson (US-6,088,700 07/11/00) in further view of Davis et al. (hereinafter Davis) U.S. Patent No. 5,796,952 issued 8/1998.



Art Unit: 2178

**In regard to dependent claim 147**, OmniForm does not specifically teach cookies. However, Davis teaches cookies (Davis column 11 lines 13-33, column 18 lines 33-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Davis to OmniForm, providing OmniForm the benefit of cookies for tracking users/data.

### ***Response to Arguments***

9. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Please note the additionally cite prior art on the accompanying PTO-892 form.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM L. BASEHOAR whose telephone number is (571)272-4121. The examiner can normally be reached on M-F: 8:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Adam L Basehoar/  
Primary Examiner, Art Unit 2178